

printing a record of the selected prizes.

42. The prize server of claim 14, wherein the prize server is a gaming machine.

43. The prize server of claim 14, wherein the prize server is configured to receive prize fulfillment information used to redeem prizes won by players playing the gaming machines.

44. The prize distribution network of claim 21, further comprising:  
a prize fulfillment center that is used to acquire and deliver prizes.

### REMARKS

Claims 1-40 are currently pending in the application. Claims 1-40 were rejected. Claims 1, 2, 7, 8, 14, 15, 20, 21, 23-25, 28, 34 and 35. Please add claims 41-44.

### *Specification*

The examiner objected to the specification in regards to claim 28 because a paper printout is being referred to as a portable memory device. The examiner notes that conventionally a memory device is electronic, magnetic medium for storing data and the specification does not disclose a paper printout in the manner of an electronic, magnetic medium. The paper printout was defined as portable memory device in the strict sense that paper is generally portable. Further, paper is generally understood in the field to serve as memory in the case of punch cards and optical scan sheets. However, for clarification purposes, claim 28 has been amended and claim 41 has been added and the objection is believed overcome thereby.

### *Claim Objections*

The examiner objected to the use of acronyms in the claims which may change over time. Claims 7, 8, 16, 20, and 34 have been amended and the objection is believed overcome thereby. The examiner objected to apparently missing language in claim 21. Claim 21 has been amended and the objection is believed overcome thereby.

### ***Rejections under 35 U.S.C. § 112***

The Examiner rejected claim 28 under 35 U.S.C. 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 28 has been amended and the rejection is believed overcome thereby.

### ***Discussion of Prior Art***

As is known in the gaming arts of the gaming industry, non-cash prizes may be awarded in the following manner. Standard gaming machines may be distributed around a carousel displaying a prize such as a car. The standard gaming machines include a pay table that specifies an award amount (which may be zero) for each possible game outcome. One possible game outcome with the lowest probability of occurring is usually designated as a jackpot. Typically, the jackpot results in the awarding of some amount of cash. When a jackpot is triggered on one of the gaming machines surrounding the carousel, the non-cash prize on the carousel is awarded in addition to the cash. Since the pay-out of a jackpot on a gaming machine usually requires intervention by an attendant, the attendant provides the information to the player that allows them to claim both the cash prize and the non-cash prize. In this manner, a standard gaming machine may be used to award a non-cash prize.

In the method described above, the standard gaming machines themselves do not contain any information regarding the non-cash prize and a player can not select the non-cash prize that corresponds to the jackpot. For instance, a different brand of car or another prize such as a motorcycle can not be selected by the player. In addition, besides the jackpot, all other winning game outcomes on the standard gaming machines surrounding the carousel result in the award of cash prizes.

### ***Rejections under 35 U.S.C. § 102***

The Examiner rejected claims 1, 3, 7, 9-12, 14, 17-22, 24-39, 31-36 and 38-39 under 35 USC 102(a) as being clearly anticipated by admitted prior disclosed in instant background of the present application.

The Examiner rejected claim 1, 3-12, 14, 16-18, 20-22 and 24-34 under 35 U.S.C. 102 (b) as being clearly anticipated by Stupak et al. (U.S. Patent No. 5851147).

The Examiner rejected claim 1, 3-12, 14, 16-22 and 29-36 under 35 U.S.C. 102 (e) as being clearly anticipated by Walker et al. (U.S. Patent No. 6068552).

The rejections are respectively traversed.

The instant background, Stupak and Walker do not describe a gaming machine where the user may select both non-cash and cash prizes as an award for a game played on the gaming machine. In the gaming industry, a player may be awarded a non-cash prize for game play on a gaming machine. However, the player is not able to select the non-cash prize i.e. it is fixed as is described in the instant background. Stupak and Walker describe gaming machine where the player may select varying amounts of cash as awards on gaming machine. However, non-cash prizes are not described. **The capability on a gaming machine of allowing a player to select non-cash prizes as awards for possible game outcomes generated on the gaming machine is a novel and non-obvious feature of the present invention.** Details of the instant background, Stupak and Walker are described as follows.

In Stupak, a video poker machine is described where the player is able to choose from among a variety of jackpots and associated pay-out schedules varying from low to high jackpot amounts. In particular, the player may choose between higher Royal Flush jackpots tied to lower pay-outs for lower ranked hands, and lower Royal Flush jack-pots tied to higher pay-outs for more frequently achieved lower-ranked hands. (Abstract). For winning combinations, the player may obtain their winnings by pressing the "cash-out" button and the machine will dispense the players winnings in the coin hopper (Col. 7, 1. 48-54). In Stupak, the figures do not show any non-cash prizes of any kind which may be awarded to a player and the specification does not describe non-cash prizes and methods of awarding non-cash prizes in any manner. Further, in Stupak, a prize server which may be used to provide prize information to an external gaming machine is not described in any manner.

In Walker, a gaming machine is described where the player may customize the odds, pay-out schedule and wager amounts and the gaming machine automatically determines changes in other parameters which were not customized to maintain a constant house advantage (Abstract). The player may customize a "cash" pay schedule which is amount paid for each real combination shown, based on an amount wagered (Col. 4, 1. 43-55). The player's preferences for customizing the gaming machine can be stored on the slot server and retrieved by the player identifier when the player inserts a player-tracking card into the machine (Col. 11, 1. 14-20). In Walker, the figures do not show or suggest any non-cash prizes of any kind which may be awarded to a player in response to a game outcome generated on the gaming machine and the specification does not describe suggest any non-cash prizes and methods of awarding non-cash prizes in any manner. For instance, FIGs. 2, 3, 4A, 4B, 5, 6, 8, 10, 11A, 11B and 12 all show amounts of credits that are awarded based on the game outcome generated on the gaming machine. The credits have a cash-value based on the amount wagered and can be used for additional game play or cashed out by the player.

In contrast, the present invention, in claim 1, allows a gaming machine with a) "a memory storing a list of prizes," where "the prizes include cash prizes and non-cash prizes"; b) "a prize display mechanism displaying the prizes stored in the memory;" and c) "a prize

selection mechanism used to select one or more prizes for one or more outcomes of a game played on the gaming machine. In Stupak and Walker, gaming machines that pay-out "cash" for a winning game outcomes are described. A gaming machine with a memory storing a list of non-cash prizes and cash prizes that may be selected for one or more game outcomes is not described or suggested in Stupak or Walker. Thus, Stupak and Walker can not be said to anticipate the present. In the instant background, a scenario is described where a player may win a non-cash prize on a gaming machine. However, in the instant background, the gaming machines do not include a memory with a list of cash prizes and non-cash prizes that can displayed on the gaming machine and selected for one or more game outcomes. Thus, the instant back ground can not be said to anticipate claim 1. Claims 2-13 depend from claim 1. Thus, the instant background, Stupak and Walker can not be said to anticipate claims 1-13. Claims 24-34 recite a method of using a gaming machine with a list of prizes, including non-cash and cash prizes, that can be selected as game outcomes. For at least the reasons cited above with respect to claim 1, the instant background, Stupak and Walker can not be said to anticipate claims 24-34. Claims 21-23 and 35-40 recite a prize distribution network with one or more gaming machines as recited in claim 1 and a method of using the prize distribution network. For at least reasons cited above with respect to claim 1, the instant background, Stupak and Walker can not be said to anticipate claims 21-23 and 35-40.

In claims 14-20, the present invention recites a prize server with an interface for providing prize information for non-cash prizes and cash prizes to one or more gaming machine connected to the prize server and a memory storing the prize information for cash prizes and the non-cash prizes. Stupak and the instant background do not describe prize servers. Walker describes a slot server that may be used to store customization information in regards to cash pay-outs on the gaming machine. However, Walker does not describe or suggest a prize server with a memory storing prize information for cash and non-cash prizes. Thus, instant background, Stupak and Walker can not be said to anticipate claims 14-20. Further, in summary, the instant background, Stupak and Walker can not be said to anticipate claims 1-40 and withdrawal of the rejections is respectfully requested.

### ***Rejections under 35 U.S.C. § 103***

The Examiner rejected claims 2, 13, 15, 23 and 37 under 34 U.S.C. 103 (a) as being unpatentable over Walker et al. (6,068,552) in view of the admitted prior art. The rejection is respectfully traversed.

The MPEP 2142, 8<sup>th</sup> edition states, To establish case of *prima facie* case of obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings or to combine reference teachings." Arguments regarding suggestion or motivation in

the Walker references and in the knowledge generally available to one of ordinary skill in the art are discussed as follows.

All claims require provisions for selecting among cash and non-cash prizes. The Walker references describe a gaming device where a user may select different payouts as an outcome for a game generated on the gaming device where a constant house advantage is maintained. However, the Walker references only allow the user to select "cash" payouts and non-cash prizes are not described. In the prior art, a gaming device has been used to award a fixed non-cash prize as part of a "jack pot" award. However, no system allows the "selection" of a non-cash prize or the selection of cash and non-cash prizes. Further, no system allows for the award of a non-cash prize other than for a jackpot. Also, no system contains a memory storing any non-cash prizes.

No prior art system (known to the applicants) suggests bridging the gap between selecting various cash payouts (and paytables) and providing non-cash awards. To the extent that non-cash awards have appeared in the prior art, they have been limited to a non-cash prize that is awarded in addition to a cash jackpot on the gaming system. Thus, the gaming system does not store any knowledge about the non-cash prize. For instance, a car or a motorcycle, which may usually be worth tens of thousands of dollars, is a typical non-cash jackpot award that is awarded in addition to a non-cash jackpot. Further, the non-cash prizes are not an award that the player can play for in the normal course of a game i.e. other than the jackpot all of the other awards are cash prizes. The examiner has stated that "merchandise, vacations, airline miles, shopping spree" and "theme" as notoriously well known or as equivalent in the gaming arts. The applicant requests the examiner to provide evidence for each of these assertions. Further, even when a non-cash award is provided, such as for a jackpot, the player can not select among the non-cash awards. For at least these reasons, the prior art fails to render the claims obvious.

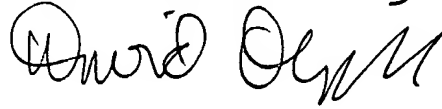
It is not surprising that the prior art has failed to suggest the claimed invention. Non-cash prizes present various logistical difficulties. For instance, most gaming jurisdictions require that a gaming device, such as slot machine, return a minimum value. As compared to cash prizes, non-cash prizes present more difficulties in regards to documenting that a minimum value is being returned by the slot machine because the non-cash prizes may not have a "fixed" value. For example, the value of a prize may depend on when and from whom it was purchased. This issue may also be important for the Walker references. In the Walker references, it is required that a constant house advantage be maintained no matter what selections of the "cash" payouts are made. Thus, even if Walker were modified, since with "non-cash" prizes the value of the non-cash prizes can change with time, it would be difficult to perform the calculations necessary to assure a constant house advantage was always maintained.

The Examiner rejected claims 27, 28, 30 and 40 under 34 U.S.C. 103 (a) as being unpatentable over Walker et al. (6,068,552) in view of Walker (6,110,041). The rejection is respectfully traversed. Neither of the Walker references, alone or in combination, teach or suggest, a gaming machine with a) a memory storing a list of prizes where the prizes include

cash prizes and non-cash prizes and b) a prize selection mechanism used to select one or more prizes for one or more outcomes of a game played on the gaming machines. For at least these reasons described above, it is respectfully submitted the Walker references can not be said to render obvious the invention as recited in Claims 27, 28, 30 and 40 and withdrawal of the rejection is respectfully requested.

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,  
BEYER WEAVER & THOMAS, LLP

A handwritten signature in black ink, appearing to read "David P. Olynick", written over the printed name.

David P. Olynick  
Reg. No.: 48,615

P.O. Box 778  
Berkeley, CA 94704-0778

## APPENDIX

1. (Amended) A gaming machine comprising:  
a memory storing a list of [one or more] prizes; and  
a prize display mechanism displaying [one or more] the prizes [available to a user] stored in the memory; and  
a prize selection mechanism [that allows the user] used to select one or more prizes [specific to] for one or more outcomes of a game played on the gaming machine  
wherein the prizes include cash prizes and non-cash prizes.
2. (Amended) The gaming machine of claim 1, wherein the non-cash prizes are selected from the group consisting of merchandise, vacations, airline miles, and shopping sprees [and cash].
3. The gaming machine of claim 1, wherein the prize selection mechanism allows the user to select one or more prizes specific to a wager amount of the game played on the gaming machine.
4. The gaming machine of claim 1, wherein the gaming machine is a mechanical slot machine, a video slot machine, a keno game, a lottery game, or a video poker game.
5. The gaming machine of claim 1, wherein a probability of the outcome of the game played on the gaming machine is specific to a value of the selected prize.
6. The gaming machine of claim 1, wherein the prize selection mechanism is a key pad, a button panel, a video touch screen, a mouse, a touch pad, a joystick, a microphone or a magnetic card.
7. (Amended) The gaming machine of claim 1, wherein the prize display mechanism is a printed sign, a video display screen, a bonus wheel, a video touch screen, an LCD (Liquid Crystal Display), a back-lit glass panel or a prize.
8. (Amended) The gaming machine of claim 1, wherein the memory is an EEPROM (Electronically Erasable Programmable-Read only Memory), a CD-ROM (Compact Disc-Read Only Memory), DVD (Digital Versatile Disc), a non-volatile memory, or a magnetic storage device.

9. The gaming machine of claim 1, wherein the gaming machine provides a display format for the one or more prizes displayed on the display mechanism.

10. The gaming machine of claim 9, wherein the display format is graphical or textual.

11. The gaming machine of claim 9, wherein the display format indicates a feature of the prize.

12. The gaming machine of claim 11, wherein the prize feature is a prize value.

13. The gaming machine of claim 11 wherein the prize feature is a prize theme.

14. (Amended) A prize server comprising;  
an interface for providing prize information to one or more gaming machines wherein at least one of the gaming machines is located external to the prize server; and  
a memory storing the prize information as groups of prizes for separate display on the one or more gaming machines  
wherein prizes include cash prizes and non-cash prizes.

15. (Amended) The prize server of claim 14, wherein the non-cash prizes are selected from the group consisting of merchandise, vacations, airline miles, and shopping sprees [and cash].

16. (Amended) The prize server of claim 14, wherein the memory is an EEPROM(Electronically Erasable Programmable-Read only Memory), a CD-ROM(Compact Disc-Read Only Memory), a non-volatile memory, or a magnetic storage device.

17. The prize server of claim 14, further comprising a second interface to an output mechanism wherein the second interface is configured to send prize information to the output mechanism.

18. The prize server of claim 17, wherein the output mechanism is a printer, a magnetic card reader, optical card reader, smart card reader, or a mechanism for electronically crediting a pre-existing account.



19. The prize server of claim 14, wherein the interface is a fiber optic cable, a coaxial cable, or a wireless interface.

20. (Amended) The prize server of claim 14, wherein the display is a video display screen, a touch screen, or a LCD (Liquid Crystal Display).

21. (Amended) A prize distribution network comprising;  
(a) a prize server comprising;  
An interface for providing prize information to one or more gaming machines  
wherein at least one of the gaming machines is external to the prize server; and  
A memory storing the prize information as groups of prizes for separate display on the one or more gaming machines; and  
(b) a plurality of gaming machines each gaming machine comprising;  
a memory storing a list of [one or more] prizes; and  
a prize display mechanism displaying [one or more ] the prizes; and  
a prize selection mechanism [that allows a user] used to select one or more prizes  
[specific to] for one or more [an] outcomes of a game played on the gaming machine  
wherein the prizes include cash prizes and non-cash prizes.

22. The prize distribution network of claim 21, wherein the machine is a mechanical slot machine, a video slot machine, a keno game, a lottery game, or a video poker game.

23. (Amended) The prize distribution network of claim 21, wherein the non-cash prizes are selected from the group consisting of merchandise, vacations, airline miles, and shopping sprees [and cash].

24. (Amended) In a gaming machine having a prize selection mechanism, a prize display mechanism for displaying a list of prizes, a method of selecting a prize specific to an outcome of a game played on a gaming machine, the method comprising;  
displaying multiple prizes available for selection in the prize display mechanism;  
receiving an input signal from the prize selection mechanism for selecting a prize from the list of prizes, said input signal corresponding to a user's selection of the selected prize;  
receiving a game play signal and determining the game play outcome; and  
presenting the game play and game play outcome  
wherein the prizes include cash prizes and non-cash prizes.

25. The method of claim 24, wherein the non-cash prizes [the list of prizes includes at least one] are selected from the group consisting of merchandise, vacations, airline miles, and shopping sprees[, or cash].

26. The method of claim 24, further comprising determining a pay table to be used in determining a game play outcome, wherein the pay table is chosen according to the value of the selected prize.

27. The method of claim 24, further comprising outputting the selected prizes to a portable memory device.

28. (Amended) The method of claim 27, wherein the portable memory device is [a paper printout,] a magnetic card, a personal digital assistant or a smart card.

29. The method of claim 24, wherein the prize selection mechanism is a key pad, a button panel, a touch screen, a mouse, touch pad, joystick, a microphone, a smart card or a magnetic card.

30. The method of claim 24, further comprising receiving a wager amount prior to receiving an input signal from the prize selection mechanism.

31. The method of claim 30, further comprising displaying a group of prizes available for selection in the prize display mechanism specific to the wager amount.

32. The method of claim 24, wherein the gaming machine is a mechanical slot machine, a video slot machine, a keno game, a lottery game, or a video poker game

33. The method of claim 24, further comprising displaying the selected prize on the prize display mechanism.

34. (Amended) The method of claim 24, wherein the prize display mechanism is a printed sign, a video display screen, a bonus wheel, a video touch screen, back-lit glass panel or an LCD (Liquid Crystal Display).

35. (Amended) In a prize distribution network comprising a plurality of gaming machines connected to a prize server, a method for distributing information about prizes available on specific gaming machines, the method comprising,

establishing communication with each gaming machine connected to the prize server; and

sending prize information from a memory on the prize server to a memory on each gaming machine, said prize information specific to prizes which are available for selection by game players as game awards on games played on the gaming machines

wherein the prizes include cash prizes and non-cash prizes.

36. The method of claim 35, wherein the machine is a mechanical slot machine, a video slot machine, a keno game, a lottery game, or a video poker game.

37. The method of claim 35, wherein the prizes are merchandise, vacations, airline miles, shopping sprees and cash.

38. The method of claim 35, further comprising displaying the prize information to a video display screen associated with one or more of the gaming machines.

39. The method of claim 38, further comprising identifying one or more prizes selected by a user.

40. The method of claim 39, further comprising outputting the selected prize information to a portable storage device, which can be read by one or more of the gaming machines.

41. The method of claim 24, further comprising:  
printing a record of the selected prizes.

42. The prize server of claim 14, wherein the prize server is a gaming machine.

43. The prize server of claim 14, wherein the prize server is configured to receive prize fulfillment information used to redeem prizes won by players playing the gaming machines.

44. The prize distribution network of claim 21, further comprising:  
a prize fulfillment center that is used to acquire and deliver prizes.